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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/015.002 01/28/98 HE

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NM11/0904

EXAMINER

FORD, J

ART UNIT

PAPER NUMBER

1611

4

DATE MAILED:

09/04/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-31 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ _____

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The claims in the application are claims 1-31.

Claims 1 and 31 are rejected under 35 U.S.C. 101, and 35 U.S.C. 112, 1st paragraph, as it is not believed on its face the any one compound could be useful for all of the purposes listed. Many of the utilities listed are extremely unlikely to be treatable, and would require considerable proof. It would require undue experimentation to determine what host-dose relationship would produce which result. MPEP 806.05(h) provides for restricting out claims 1 and 31 from the application, as applicants allege more than one use for their compounds. Applicants should cancel claims 1-3 and 31, or rewrite them limiting them to one method of use. This is the consistent with the practice in 371 cases, as provided by 37 CFR 1.475, and PCT cases by Article 13.2.

What is the purpose of the proviso statement at the end of claim 4? It is assumed that is art in view of the disclosures at pages 4-8 of the specification. See *In re Nomiya*, 184 USPQ 607; prior art, noted by applicant, may be used as evidence of obviousness under 35 U.S.C. 103.

Claims 4-~~29~~ are rejected over the prior art noted by applicant on pages 4-8 of the specification. The compounds removed by exception at the end of claim 4 have next adjacent compounds. Those next adjacent compound would be structurally obvious.

E. g., *Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904. See also *Deuel*, 51 F.3d at 1558, 34 USPQ2d at 1214 ("Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of

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ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties.”).

Other structural similarities have been found to support a prima facie case of obviousness. E.g., *In re May*, 574 F.2d 1082, 1093-95, 197 USPQ 601, 610-11 (CCPA 1978) (stereo isomers); *In re Wilder*, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 USPQ 39, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

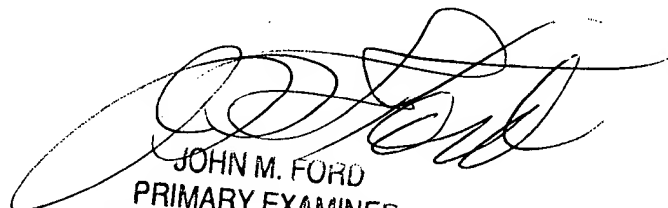
A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness. The name used to designate the structural relationship between compounds is not controlling, it is the closeness of that relationship. *In re Payne et al.* (CCPA 1979) 606 F.2d 303, 203 USPQ 245. When chemical compounds have “very close” structural similarities and similar utilities, without more a prima facie case of obviousness may be made. *In re Grabiak* (CAFC 1985) 769 F.2d 729, 226 USPQ 870. Thus, a difluorinated compound was held unpatentable over the prior art dischloro compound on the basis of analogical reasoning. *Ex parte Wiseman* (POBA 1953) 98 USPQ 277.

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Claims 2, 3 and 30 are rejected as being dependent on a rejected claim.


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1611

J. Ford:jmr

Aug. 31, 1998